

### REMARKS

In the Office Action dated December 9, 2004, claims 1-17 and 20-21 were rejected under 35 U.S.C. § 103 over U.S. Patent No. 5,959,547 (Tubel) in view of U.S. Patent No. 5,008,664 (More); and claims 18 and 19 were rejected under § 103 over Tubel and More in view of U.S. Patent No. 5,542,472 (Pringle).

It is respectfully submitted that the Office Action has failed to establish a *prima facie* case of obviousness against claim 1, as there existed no motivation or suggestion to combine the teachings of Tubel and More to achieve the claimed invention. *See* M.P.E.P. § 2143 (8<sup>th</sup> ed., Rev. 2), at 2100-129.

Claim 1 recites an apparatus for use in a well having a main bore and a lateral branch, the lateral branch comprising an electrical device, and the apparatus comprising an inductive coupler mechanism to electrically communicate electrical signaling in the main bore with the electrical device in the lateral branch.

As conceded in the Office Action, Tubel fails to teach the inductive coupler mechanism as recited in claim 1. However, the Office Action relied upon More as teaching such an inductive coupler mechanism. Note that More teaches use of an inductive coupler mechanism to couple components inside a main wellbore -- there is no suggestion of using the same technique to connect between a main wellbore and a lateral branch. Although Tubel teaches electrical communication between the main wellbore and a lateral branch, it does not suggest that an inductive coupler mechanism can be used to electrically communicate electrical signaling in the main bore with the electrical device in the lateral branch. The only suggestion of such a combination is provided by the present application itself -- therefore, the obviousness rejection of claim 1 is based on impermissible hindsight that benefited from the teachings of the present application.

Objectively, looking to the teachings of Tubel and More, a person of ordinary skill in the art would not have been motivated to combine their teachings. Electrically coupling components in a main wellbore and lateral branch is associated with challenges that are not present in coupling components within a main wellbore. Neither Tubel nor More suggests the use of an inductive coupler mechanism to address these challenges. Therefore, a *prima facie* case of obviousness has not been established with respect to claim 1 over Tubel and More.

Independent claim 2 recites a connector mechanism to connect equipment in a main bore to equipment in a lateral branch, and a first inductive coupler portion attached to the connector mechanism to communicate electrical signaling with the lateral branch equipment. As noted above, there is no motivation to combine Tubel and More to achieve the recited subject matter. Furthermore, even if Tubel and More can be properly combined, there is no teaching or suggestion by the hypothetical combination of Tubel and More of a first inductive coupler portion *attached to the connector mechanism* to communicate electrical signaling with the lateral branch equipment. Therefore, a *prima facie* case of obviousness has not been established with respect to claim 2.

Dependent claims of claim 2 are allowable for at least the same reasons. Moreover, with respect to newly added dependent claim 22, neither Tubel nor More teaches a tubing having a lower portion, where the lower portion of the tubing has a second inductive coupler portion, and where the connector mechanism (which connects equipment in the main bore to equipment in the lateral branch equipment) has a third inductive coupler portion and a receptacle to receive the lower portion of the tubing to position the second inductive coupler portion next to the third inductive coupler portion.

With respect to dependent claim 23, which depends from claim 22, there is no teaching in either Tubel or More of a module to engage an internal profile of a connector mechanism (that connects equipment in the main bore to equipment in the lateral branch), where the module has a fourth inductive coupler portion that is positioned next to the first inductive coupler portion when the module is engaged to the internal profile of the connector mechanism.

With respect to independent claim 8, there is no motivation or suggestion to combine the teachings of Tubel and More to achieve a completion string that includes equipment in the main bore and in the lateral branch, a first inductive coupler assembly proximal the equipment in the main bore, and a second inductive coupler assembly proximal the equipment in the lateral branch, and an electrical cable connecting the first and second inductive coupler assemblies. Tubel fails to teach first and second inductive coupler assemblies, and More fails to teach the second inductive coupler assembly proximal equipment in the lateral branch. No suggestion existed in either of the references to combine their teachings to achieve the claimed invention. Therefore, a *prima facie* case of obviousness has not been established with respect to claim 8.

Claims dependent from claim 8 are allowable for at least the same reasons.

Independent claim 20 is also allowable over the asserted combination of Tubel and More, since no motivation or suggestion existed to combine the teachings of Tubel and More to achieve the provision of a first inductive coupler assembly electrically connected to main bore equipment and in communication with lateral branch equipment.

Claims dependent from claim 20 are allowable for at least the same reasons. Moreover, with respect to newly added dependent claim 25, which depends from claim 21, there is no teaching in Tubel or More of providing a connector to connect the main bore equipment to the lateral branch equipment, where the connector has a receptacle to receive the main bore equipment, and the connector having a portion of the first inductive coupler assembly.

With respect to claim 26, which depends from claim 25, there is no teaching in either Tubel or More of main bore equipment including a tubing having a lower portion to engage in the receptacle of the connector, and the lower portion of tubing having another portion of the first inductive coupler assembly.

With respect to claim 27, which depends from claim 26, there is no teaching by either Tubel or More of providing a module into the connector (that connects the main bore equipment to the lateral branch equipment), where the module has a portion of the second inductive coupler assembly, and the connector has another portion of the second inductive coupler assembly.

In view of the foregoing, allowance of all claims is respectfully requested. The Commissioner is authorized to charge any additional fees and/or credit any overpayment to Deposit Account No. 20-1504 (SHL.0152D1US).

Respectfully submitted,

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